

ESTTA Tracking number: **ESTTA649899**

Filing date: **01/14/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	PEI Licensing, Inc.
Granted to Date of previous extension	01/18/2015
Address	3000 N.W. 107th Avenue Miami, FL 33172 UNITED STATES
Attorney information	Tom Monagan Norvell IP LLC (12232-1470) P.O. Box 2461 Chicago, IL 60690 UNITED STATES officeactions@norvellip.com, tmonagan@norvellip.com

### Applicant Information

Application No	86215200	Publication date	07/22/2014
Opposition Filing Date	01/14/2015	Opposition Period Ends	01/18/2015
Applicant	Zwick, Steven Unit 1010 Arlington, VA 22204 UNITED STATES		

### Goods/Services Affected by Opposition


Class 025. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Clothing, namely, shirts

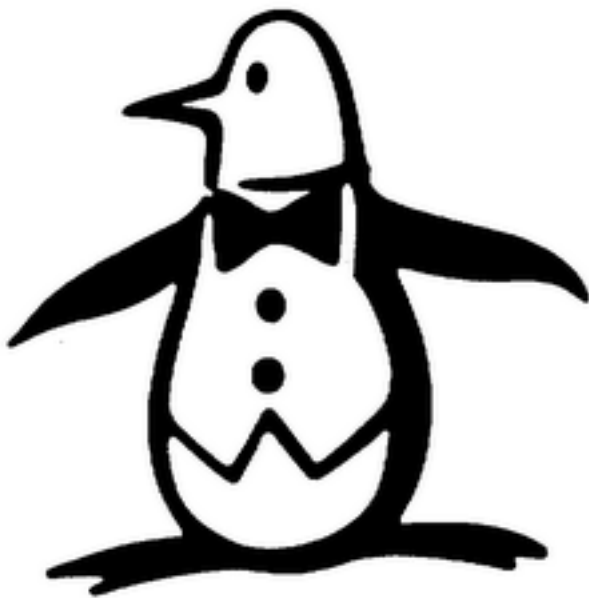
### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


### Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	673912	Application Date	10/28/1957
Registration Date	02/10/1959	Foreign Priority Date	NONE
Word Mark	NONE		


Design Mark	
Description of Mark	NONE
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1956/02/21 First Use In Commerce: 1956/02/21 GOLF SHIRTS AND OTHER SPORTSWEAR-NAMELY, SPORT SHIRTS, [ BOWLING SHIRTS ], SWEATERS [, AND BEACH JACKETS ]

U.S. Registration No.	1116035	Application Date	03/31/1978
Registration Date	04/03/1979	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			

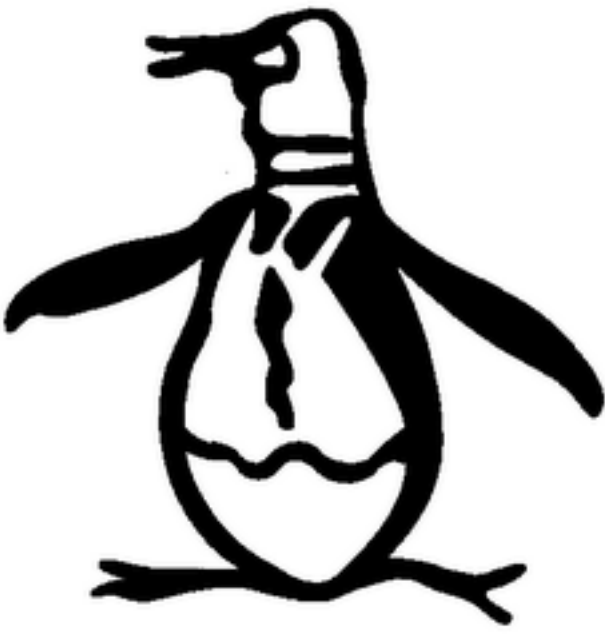
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 1977/07/15 First Use In Commerce: 1977/07/15 BARREL BAGS AND GOLF UMBRELLAS Class 025. First use: First Use: 1977/07/13 First Use In Commerce: 1977/11/22 [ GOLF CAPS ] Class 028. First use: First Use: 1969/00/00 First Use In Commerce: 1969/00/00 GOLF BAG COVERS, GOLF BALLS, GOLF TEES,[ RACKET COVERS AND TENNIS BAGS ]


U.S. Registration No.	2075922	Application Date	01/10/1992
Registration Date	07/01/1997	Foreign Priority Date	NONE
Word Mark	PENGUIN SPORT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1992/01/00 First Use In Commerce: 1992/01/00 clothing; namely, men's, women's and children's tops, shirts, skirts, pullover windshirts, pants, shorts, sweat shirts,jackets, hosiery, hats, scarves, gloves, footwear; activewear; namely, jackets,pullover windshirts, sweaters, shirts, skirts, shorts, pants, swimwear, warm-upsuits, training suits, sweat suits, sweat shirts, sweat shorts, sweat pants, footwear, hosiery, hats, scarves and gloves; and sportswear; namely, shorts, jackets, pullover windshirts, shirts, skirts,pants, warm-up suits, training suits, sweat suits, sweat shirts, sweat shorts, sweat pants, hosiery, hats, scarves, gloves and footwear		

U.S. Registration No.	2749389	Application Date	08/17/2001
Registration Date	08/12/2003	Foreign Priority Date	NONE
Word Mark	PENGUIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1967/06/00 First Use In Commerce: 1967/06/00 Slacks, walking shorts, sport shirts, and jackets		

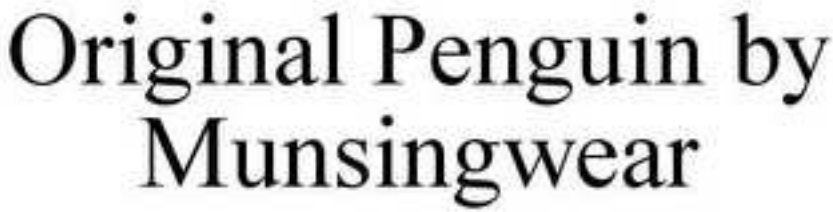
U.S. Registration No.	2870641	Application Date	07/18/2002
Registration Date	08/03/2004	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed Penguin with an orange beak and orange feet.		
Goods/Services	Class 025. First use: First Use: 2003/02/00 First Use In Commerce: 2003/02/00 Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely, shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks		


U.S. Registration No.	2880454	Application Date	07/18/2002
Registration Date	08/31/2004	Foreign Priority Date	NONE
Word Mark	NONE		

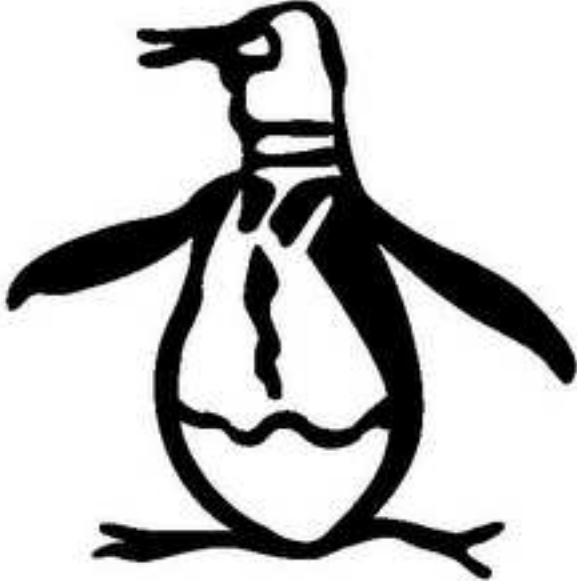
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2003/02/00 First Use In Commerce: 2003/02/00 CLOTHING, NAMELY, KNIT AND WOVEN SHIRTS, T-SHIRTS, SWEAT-SHIRTS, OUTERWEAR IN THE NATURE OF WIND-RESISTANT JACKETS, JACKETS, COATS, VESTS, PANTS, SHORTS, SWEATERS, HEADWEAR, NAMELY, HATS, CAPS, VISORS AND HEADBANDS, FOOTWEAR, NAMELY SHOES, SNEAKERS AND SANDALS, TIES, WRISTBANDS, BELTS FOR CLOTHING, SWIMSUITS, HOSIERY, UNDERWEAR AND SOCKS

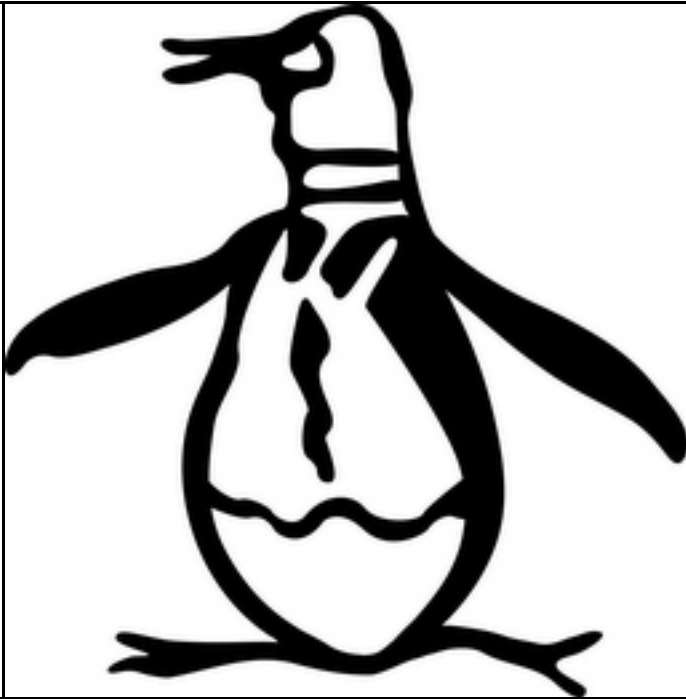
U.S. Registration No.	3323720	Application Date	03/26/2007
Registration Date	10/30/2007	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	The mark consists of a picture of a penguin and the words An Original Penguin by Munsingwear.		
Goods/Services	Class 025. First use: First Use: 2003/02/00 First Use In Commerce: 2003/02/00 Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the		

	nature of wind resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely, shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks
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U.S. Registration No.	3681969	Application Date	01/17/2008
Registration Date	09/15/2009	Foreign Priority Date	NONE
Word Mark	ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2007/11/15 First Use In Commerce: 2007/11/15 LUGGAGE, LUGGAGE STRAPS, TRAVEL BAGS, GARMENT BAGS AND SHOE BAGS FOR TRAVEL, BRIEFCASES, BRIEFCASE-TYPE PORTFOLIOS, ATTACHE CASES, MESSENGER BAGS, HANDBAGS, POCKETBOOKS, LEATHER AND FABRIC EVENING BAGS, CLUTCHES, TOTE BAGS, ATHLETIC BAGS, DUFFEL BAGS, BEACH BAGS, DIAPER BAGS, COSMETIC BAGS SOLD EMPTY, TOILETRY CASES SOLD EMPTY, SCHOOL BAGS, KNAPSACKS, WAISTPACKS, UMBRELLAS, WALLETTS, BILLFOLDS, BUSINESS CARD CASES, CREDIT CARD CASES, KEY CASES, CHANGE PURSES		


U.S. Registration No.	3717328	Application Date	01/17/2008
Registration Date	12/01/2009	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 WATCHES, CLOCKS, PARTS OF WATCHES AND CLOCKS, AND THEIR		

	CASES		
U.S. Registration No.	3717329	Application Date	01/17/2008
Registration Date	12/01/2009	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a design of a penguin.		
Goods/Services	<p>Class 014. First use: First Use: 2005/03/00 First Use In Commerce: 2005/03/00 WATCHES, CLOCKS, PARTS OF WATCHES AND CLOCKS, AND THEIR CASES</p> <p>Class 018. First use: First Use: 2007/11/15 First Use In Commerce: 2007/11/15 LUGGAGE, LUGGAGE STRAPS, TRAVEL BAGS, GARMENT BAGS AND SHOE BAGS FOR TRAVEL, BRIEFCASE, BRIEFCASE-TYPE PORTFOLIOS, ATTACHE CASES, MESSENGER BAGS, HANDBAGS, POCKETBOOKS, LEATHER AND FABRIC EVENING BAGS, CLUTCHES, TOTE BAGS, ATHLETIC BAGS, DUFFEL BAGS, BEACH BAGS, DIAPER BAGS, COSMETIC BAGS SOLD EMPTY, TOILETRY CASES SOLD EMPTY, SCHOOL BAGS, KNAPSACKS, WAIST PACKS, UMBRELLAS, WALLETS, BILLFOLDS, BUSINESS CARD CASES, CREDIT CARD CASES, KEY CASES, CHANGE PURSES</p>		
U.S. Registration No.	3811401	Application Date	03/25/2008
Registration Date	06/29/2010	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a penguin.
Goods/Services	Class 025. First use: First Use: 2009/07/31 First Use In Commerce: 2009/07/31 Snowboard boots Class 028. First use: First Use: 2009/07/31 First Use In Commerce: 2009/07/31 Snowboards and snowboard bindings

U.S. Registration No.	3894274	Application Date	03/25/2008
Registration Date	12/21/2010	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark	<p>An Original Penguin by Munsingwear</p>		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2009/07/31 First Use In Commerce: 2009/07/31 snowboard boots Class 028. First use: First Use: 2009/07/31 First Use In Commerce: 2009/07/31 snowboards and snowboard bindings		

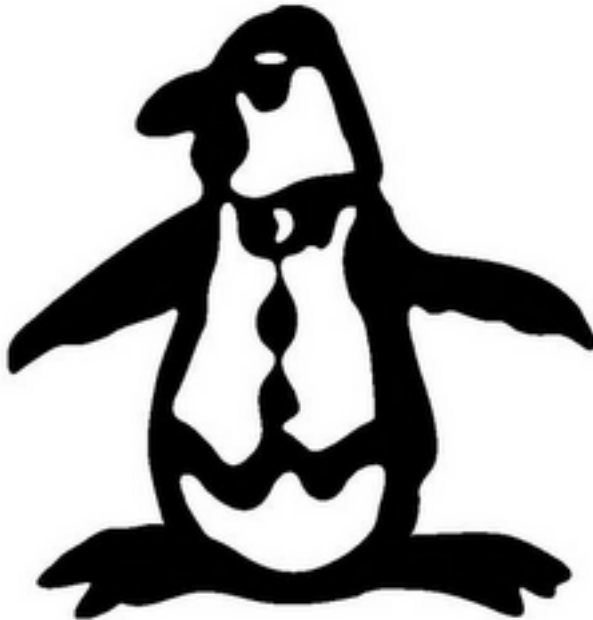
U.S. Registration No.	3961901	Application Date	10/27/2010
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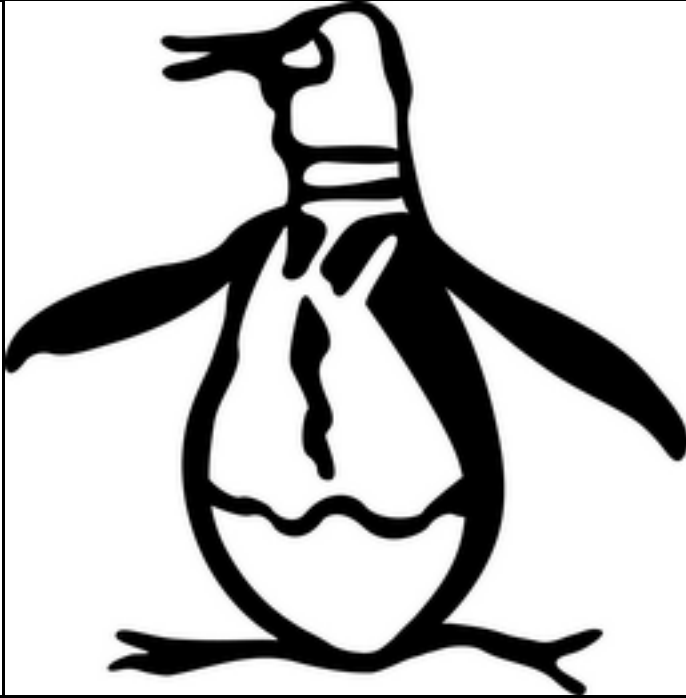
Registration Date	05/17/2011	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	The mark consists of the wording "AN ORIGINAL PENGUIN BY MUNSINGWEAR" in stylized form with the letter "M" contained in a square which has four curved sides.		
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods		

U.S. Registration No.	3961902	Application Date	10/27/2010
Registration Date	05/17/2011	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods		

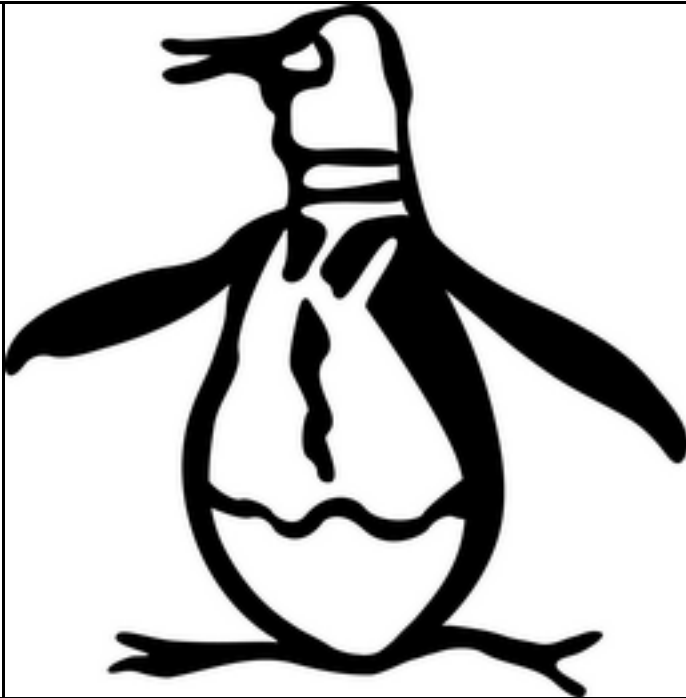
U.S. Registration No.	4032486	Application Date	06/23/2010
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Registration Date	09/27/2011	Foreign Priority Date	NONE
Word Mark	ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark	<p>Original Penguin by Munsingwear</p>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2011/04/01 First Use In Commerce: 2011/04/01 fragrances, namely, perfumes, eau de parfum, cologne, eau de toilet, body lotion, bath gel, hand soap, perfumed soap and cosmetics		

U.S. Registration No.	4058748	Application Date	11/02/2010
Registration Date	11/22/2011	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed Penguin.		
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods		


U.S. Registration No.	4058749	Application Date	11/02/2010
Registration Date	11/22/2011	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed Penguin.		
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods		


U.S. Registration No.	4132700	Application Date	11/11/2010
Registration Date	04/24/2012	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a dressed penguin.
Goods/Services	Class 003. First use: First Use: 2011/04/01 First Use In Commerce: 2011/04/01 FRAGRANCES, NAMELY, PERFUMES, EAU DE PARFUM, COLOGNE, EAU DE TOILET, BODY LOTION, BATH LOTION, BATH GEL, HAND SOAP, PERFUMED SOAP AND COSMETICS

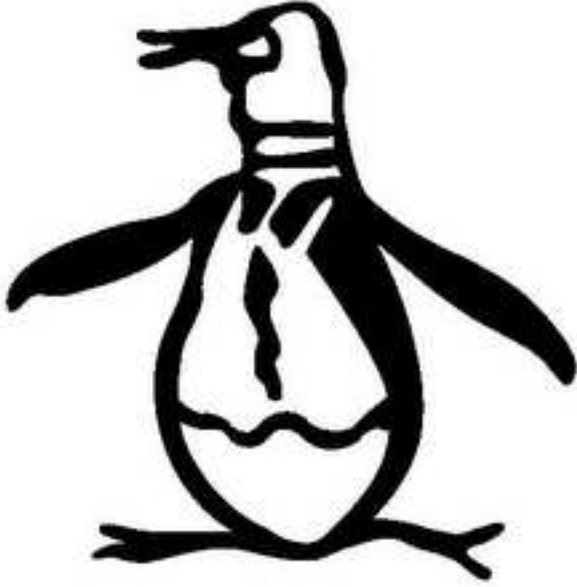
U.S. Registration No.	4263091	Application Date	10/27/2010
Registration Date	12/25/2012	Foreign Priority Date	NONE
Word Mark	PENGUIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/05/01 First Use In Commerce: 2005/05/01 Eyewear and eyewear accessories, namely, frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods		


U.S. Registration No.	4308261	Application Date	07/03/2012
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Registration Date	03/26/2013	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	The mark consists of a dressed penguin on the left side with a vertical line separating the design and the words "AN ORIGINAL PENGUIN BY MUNSINGWEAR" in stylized format.		
Goods/Services	Class 035. First use: First Use: 2010/11/11 First Use In Commerce: 2010/11/11 Retail store services featuring apparel, hats, leather goods, fashion accessories, jewelry, footwear, cosmetics, personal care products, eyewear, luggage and sports equipment		

U.S. Registration No.	4481609	Application Date	11/18/2011
Registration Date	02/11/2014	Foreign Priority Date	NONE
Word Mark	AN ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	The mark consists of the words "an original Penguin By Munsingwear" in stylized format with the "M" in "Munsingwear" in a dark background.		
Goods/Services	Class 014. First use: First Use: 2013/09/00 First Use In Commerce: 2013/09/00 WATCHES, JEWELRY, NAMELY, RINGS, BRACELETS, NECKLACES, CUFF-LINKS, AND TIE BARS		

U.S. Registration No.	4598008	Application Date	01/17/2013
Registration Date	09/02/2014	Foreign Priority	NONE

		Date	
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a dressed penguin.		
Goods/Services	Class 025. First use: First Use: 2013/04/30 First Use In Commerce: 2013/04/30 dress shirts and tuxedo shirts; men's, women's and children's underwear, sleepwear, loungewear, pajamas and robes		

U.S. Registration No.	4598009	Application Date	01/17/2013
Registration Date	09/02/2014	Foreign Priority Date	NONE
Word Mark	ORIGINAL PENGUIN BY MUNSINGWEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2013/04/30 First Use In Commerce: 2013/04/30 dress shirts and tuxedo shirts; men's, women's and children's underwear, sleepwear, loungewear, pajamas and robes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	PENGUIN word mark and penguin design marks as protected under the common law
Goods/Services	All goods in Class 25

Attachments	72039655#TMSN.png( bytes ) 73164596#TMSN.png( bytes ) 74236566#TMSN.png( bytes ) 76301300#TMSN.png( bytes ) 78975441#TMSN.png( bytes ) 78975440#TMSN.png( bytes ) 77139980#TMSN.png( bytes ) 77373863#TMSN.png( bytes ) 77374580#TMSN.png( bytes ) 77374640#TMSN.png( bytes ) 77430538#TMSN.png( bytes ) 77430496#TMSN.png( bytes ) 85162396#TMSN.png( bytes ) 85162707#TMSN.png( bytes ) 85069700#TMSN.png( bytes ) 85166869#TMSN.png( bytes ) 85166877#TMSN.png( bytes ) 85174948#TMSN.png( bytes ) 85162406#TMSN.png( bytes ) 85668368#TMSN.png( bytes ) 85476255#TMSN.png( bytes ) 85826054#TMSN.png( bytes ) 85826140#TMSN.png( bytes ) 150114 Notice of Opposition (12232-1470).pdf(412568 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Aaron H. Midler/
Name	Aaron H. Midler
Date	01/14/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No.: 86/215,200  
Filed: March 7, 2014



Mark:

Published in the *Official Gazette* (Trademarks) on July 22, 2014

PEI LICENSING, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
Steven Zwick	)	
	)	
Applicant	)	

**NOTICE OF OPPOSITION**

PEI LICENSING, INC., a Delaware corporation with a principal place of business at 3000 NW 107th Avenue, Miami, Florida 33172 ("PEI Licensing") believes that it will be damaged by the registration of the penguin design mark shown in Application Serial No. 86/215,200 ("Opposed Mark"), applied for by Steven Zwick, an individual with an address of 5500 Columbia Pike #1010, Arlington Virginia 22204 ("Applicant"), and PEI Licensing opposes registration on the basis of a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), and dilution under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c). In support of its

Opposition, PEI Licensing asserts as follows:

### **PEI Licensing's PENGUIN Marks**

1. PEI Licensing and its related companies are leading marketers of a broad line of apparel, accessories and related goods.

2. PEI Licensing is the owner and licensor of a number of well-known, globally recognized brands, including, for example, PERRY ELLIS<sup>®</sup>, JANTZEN<sup>®</sup>, LAUNDRY BY SHELLI SEGAL<sup>®</sup>, MANHATTAN<sup>®</sup>, ORIGINAL PENGUIN<sup>®</sup>, and several penguin designs:









3. PEI Licensing's and its related companies' goods are distributed through regional, national and international department stores, national and regional chain stores, mass merchants and green-grass and other specialty stores. PEI Licensing, through its related companies, also engages in direct-to-consumer business through company-owned retail stores and e-commerce websites.



4. PEI Licensing, through its predecessors and/or related companies, adopted and first used a penguin design on or in connection with apparel and related goods since at least as early as 1956 and the PENGUIN word mark since at least as early as 1967. Since that date, PEI Licensing, through its predecessors and/or related companies, has continuously used the penguin design and the PENGUIN word mark, in addition to a number of PENGUIN-formative marks and penguin designs.



5. PEI Licensing owns the following U.S. registrations, all of which are legally and validly registered on the Principal Register of the United States Patent and Trademark Office





("USPTO") (collectively, the "PEI Registrations"):

Mark	Reg. No.	Goods/Services	Status
	673,912	Golf shirts and other sportswear, namely, sport shirts, sweaters	Incontestable
	1,116,035	Barrel bags and golf umbrellas; golf bag covers, golf balls, golf tees	Incontestable
PENGUIN  SPORT	2,075,922	Clothing; namely, men's, women's and children's tops, shirts, skirts, pullover windshirts, pants, shorts, sweat shirts, jackets, hosiery, hats, scarves, gloves, footwear; activewear; namely, jackets, pullover windshirts, sweaters, shirts, skirts, shorts, pants, swimwear, warm-up suits, training suits, sweat suits, sweat shirts, sweat shorts, sweat pants, footwear, hosiery, hats, scarves and gloves; and sportswear; namely, shorts, jackets, pullover windshirts, shirts, skirts, pants, warm-up suits, training suits, sweat suits, sweat shirts, sweat shorts, sweat pants, hosiery, hats, scarves, gloves and footwear	Incontestable
<b>PENGUIN</b>	2,749,389	Slacks, walking shorts, sports shirts, and jackets	Incontestable

	2,870,641	Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely, shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks	Incontestable
	2,880,454	Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind-resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks	Incontestable
	3,323,720	Clothing, namely, knit and woven shirts, t-shirts, sweatshirts, outerwear in the nature of wind resistant jackets, jackets, coats, vests, pants, shorts, sweaters, headwear, namely, hats, caps, visors and headbands, footwear, namely, shoes, sneakers and sandals, ties, wristbands, belts for clothing, swimsuits, hosiery, underwear and socks	Incontestable



<b>ORIGINAL PENGUIN BY MUNSINGWEAR</b>	3,681,969	Luggage, luggage straps, travel bags, garment bags and shoe bags for travel, briefcases, briefcase-type portfolios, attache cases, messenger bags, handbags, pocketbooks, leather and fabric evening bags, clutches, tote bags, athletic bags, duffel bags, beach bags, diaper bags, cosmetic bags sold empty, toiletry cases sold empty, school bags, knapsacks, waist packs, umbrellas, wallets, billfolds, business card cases, credit card cases, key cases, change purses	Registered
<b>AN ORIGINAL PENGUIN</b>	3,717,328	Watches, clocks, parts of watches and clocks, and their cases	Registered
	3,717,329	Watches, clocks, parts of watches and clocks, and their cases; Luggage, luggage straps, travel bags, garmentbags and shoe bags for travel, briefcase, briefcase-type portfolios, attache cases, messenger bags, handbags, pocketbooks, leather and fabric evening bags, clutches, tote bags, athletic bags, duffel bags, beach bags, diaper bags, cosmetic bags sold empty, toiletry cases sold empty, school bags, knapsacks, waist packs, umbrellas, wallets, billfolds, business card cases, credit card cases, key cases, change purses	Registered
	3,811,401	Snowboard boots; snowboards and snowboard bindings	Registered

<b>AN ORIGINAL PENGUIN BY MUNSINGWEAR</b>	3,894,274	Snowboard boots; Snowboards and snowboard bindings	Registered
	3,961,901	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	Registered
<b>AN ORIGINAL PENGUIN BY MUNSINGWEAR</b>	3,961,902	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	Registered
<b>ORIGINAL PENGUIN BY MUNSINGWEAR</b>	4,032,486	Fragrances, namely, perfumes, eau de parfum, cologne, eau de toilet, body lotion, bath gel, hand soap, perfumed soap and cosmetics	Registered
	4,058,748	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	Registered

	4,058,749	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	Registered
	4,132,700	Fragrances, namely, perfumes, eau de parfum, cologne, eau de toilet, body lotion, bath lotion, bath gel, hand soap, perfumed soap and cosmetics	Registered
<b>PENGUIN</b>	4,263,091	Eyewear and eyewear accessories, namely frames for prescription and non-prescription eyeglasses and sunglasses, prescription and non-prescription sunglasses, eyeglass and sunglass chains, eyeglass and sunglass lenses, and cases for all the aforementioned goods	Registered
   <i>an original</i> <b>Penguin</b> BY Munsingwear	4,308,261	Retail store services featuring apparel, hats, leather goods, fashion accessories, jewelry, footwear, cosmetics, personal care products, eyewear, luggage and sports equipment	Registered
<i>an original</i> <b>Penguin</b> BY Munsingwear	4,481,609	Watches, jewelry, namely, rings, bracelets, necklaces, cufflinks, and tie bars	Registered
	4,598,008	Dress shirts and tuxedo shirts; men's, women's and children's underwear, sleepwear, loungewear, pajamas and robes	Registered

<b>ORIGINAL PENGUIN BY MUNSINGWEAR</b>	4,598,009	Dress shirts and tuxedo shirts; men's, women's and children's underwear, sleepwear, loungewear, pajamas and robes	Registered
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6. PEI Licensing also owns the following pending United States trademark applications, which were legally and validly filed with the USPTO (collectively, the “PEI Applications”):

	86/104,025	Cases for electronics, namely, iPhones, smart phones, iPads and tablets, headphones, ear buds and stylus	Pending
<b>AN ORIGINAL PENGUIN BY MUNSINGWEAR</b>	86/104,024	Cases for electronics, namely, iPhones, smart phones, iPads, tablets, headphones, ear buds and stylus	Pending
	86/104,021	Cases for electronics, namely, iPhones, smart phones, iPads and tablets, headphones, ear buds and stylus	Pending

7. PEI Licensing also owns extensive common law rights in its penguin designs and PENGUIN word marks in connection with a wide variety of apparel, accessories and related goods and services. PEI Licensing and/or its related companies (hereafter, “PEI”) promote and sell these goods and services under its penguin designs and PENGUIN word marks in retail stores and on its website [www.originalpenguin.com](http://www.originalpenguin.com), where the marks are prominently displayed.

8. As a result of PEI’s long-standing, nationwide, and widespread use, PEI Licensing owns extensive common law rights in the penguin designs and PENGUIN word marks in connection with a wide variety of apparel, accessories and related goods and services. The marks reflected in the PEI Registrations and PEI Applications together with the extensive common law rights in the penguin designs and PENGUIN word marks are hereafter referred to

as the “PENGUIN Marks.”

9. Long prior to the filing date of the application for the Opposed Mark, PEI extensively advertised, promoted, and sold products bearing the PENGUIN Marks as companion products originating from the same source. The PENGUIN Marks have been so extensively used and advertised together that goods bearing the PENGUIN Marks are recognized by trade and consumers as companions and as originating from a single source. As a result, the PENGUIN Marks constitute a family of PENGUIN Marks that identify PEI Licensing as the source of the goods provided.

10. PEI has expended substantial sums of money in marketing, advertising, and promoting its PENGUIN Marks and, through such sales and advertising, has generated substantial goodwill and customer recognition in its PENGUIN Marks. The public has come to associate the PENGUIN Marks exclusively with PEI Licensing.

11. PEI has derived substantial revenues from the sale of its products under the PENGUIN Marks.

12. PEI’s extensive use and advertising of the PENGUIN Marks have resulted in consumer recognition that the PENGUIN Marks identify PEI Licensing as the source of fashionable, high-quality products. The PENGUIN Marks are distinctive of PEI’s products and are well known and famous, and valuable goodwill has been generated in the PENGUIN Marks. Such goodwill was generated long before the filing date and use of the Opposed Mark.

13. The PENGUIN Marks have become, prior to Applicant’s filing and use of the Opposed Mark, distinctive and famous under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

### **Applicant's Application to Register the Opposed Mark**

14. On March 7, 2014, Applicant filed an intent-to-use application to register the Opposed Mark in connection with “[c]lothing, namely, shirts” in International Class 25. The application was assigned Serial No. 86/215,200.

15. Applicant's filing of the Opposed Mark in connection with shirts is without the consent or permission of PEI Licensing.

16. On July 2, 2014, the USPTO issued a Notice of Publication and the Opposed Mark was published in the *Official Gazette* of the USPTO on July 22, 2014.

17. Long before Applicant's filing of the Opposed Mark, PEI adopted, first used, and registered its PENGUIN Marks on or in connection with apparel and accessories, including shirts. Since then, PEI has continuously used and has not abandoned the PENGUIN Marks.

18. The goods for which Applicant seeks registration of the Opposed Mark are identical to and/or closely related to the goods and services in connection with which PEI uses its PENGUIN Marks and for which PEI Licensing owns registrations.

### **OPPOSITION BASED UPON LIKELIHOOD OF CONSUMER CONFUSION**

19. PEI Licensing repeats and realleges the allegations of Paragraphs 1 through 18 above, as though fully set forth herein.

20. PEI has used the PENGUIN Marks in United States commerce prior to Applicant's adoption, use, and application to register the Opposed Mark. Moreover, PEI Licensing registered its penguin designs (Reg. Nos. 673,912; 2,880,454; 2,870,641) and PENGUIN word mark (Reg. No. 2,749,389), among other penguin designs and PENGUIN word marks, prior to Applicant's adoption and application to register the Opposed Mark.

21. Applicant's Opposed Mark is confusingly similar to PEI Licensing's family of

PENGUIN Marks, and registration and use thereof by Applicant in connection with Applicant's Goods is likely to cause confusion, mistake, or deception that Applicant's goods are those of PEI or are otherwise endorsed, sponsored, or approved by PEI Licensing, or cause confusion, mistake, or deception as to the affiliation, connection, or association between Applicant and PEI Licensing.

22. If Applicant is permitted to use and register the Opposed Mark in connection with Applicant's Goods, confusion in trade resulting in irreparable damage and injury to PEI Licensing would be caused by reason of the similarity between the Opposed Mark and PEI Licensing's family of PENGUIN Marks. Consumers are likely to buy Applicant's goods incorrectly believing that such products are provided by, endorsed by or associated with PEI Licensing.

23. If Applicant is granted registration for the Opposed Mark as shown in Application Serial No. 86/215,200, Applicant would thereby obtain a *prima facie* exclusive right to use such mark, and such Registration would be the source of irreparable damage and injury to PEI Licensing.

24. Accordingly, Applicant's application to register the Opposed Mark must be refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), as amended.

### **OPPOSITION BASED UPON DILUTION**

25. PEI Licensing repeats and realleges the allegations of Paragraphs 1 through 24 above, as though fully set forth herein.

26. Applicant's use of the Opposed Mark in commerce in connection with Applicant's Goods dilutes, or is likely to dilute, the distinctive quality and reputation of PEI Licensing's famous PENGUIN Marks under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

27. If Applicant is permitted to use and register the Opposed Mark in connection with Applicant's Goods dilution of the distinctive quality and reputation of PEI Licensing's famous PENGUIN Marks would result in irreparable damage and injury to PEI Licensing.

28. Accordingly, Applicant's application to register the Opposed Mark must be refused registration under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), as amended.

### **PRAYER FOR RELIEF**

WHEREFORE, PEI Licensing prays that the application to register the mark as shown in Application Serial No. 86/215,200 be refused.

PEI Licensing submits herewith the requisite filing fee in the amount of \$300. The Board is authorized to charge PTO Deposit Account No. 50-4454 for any additional charges or fees related to this filing.

Respectfully submitted,

PEI LICENSING, INC.

Dated: January 14, 2015

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*Attorneys for PEI LICENSING, INC.*

## **CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION has been served upon the Applicant, Steven Zwick, via United States mail, postage prepaid, with a courtesy copy by email, addressed to:

Steven Zwick  
5500 Columbia Pike #1010  
Arlington Virginia 22204  
steven.zwick@gmail.com

Dated: January 14, 2015

By: s/Aaron H. Midler/  
Aaron H. Midler